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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,891

Applicant(s)

Kaddeche et al.

Examiner

John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 9, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM OBJECTIONS—37 CFR 1.75

37 CFR 1.75(a) requires:

“The specification must conclude with . . . [claims] particularly pointing out and distinctly claiming the subject matter which the applicant regards as his/her invention or discovery.”

2. Claims 4 & 11 are objected to because of typographical errors.

Claim 4, line 5 recites: “An electronelectronelectronic mail to be sent to th’m(.OU”; furthermore, claim 4 is objected to because it does not end with a period.

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Claim 11, line 1 recites "a computer to transmitting[sic] targeted information. . . ."

Appropriate corrections are required.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. §103(a) as being obvious over Root 6,013,007 (1/11/2000) [US f/d: 03/26/1998] (herein referred to as "Root").

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As per claim 1, Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows “A method of targeting an Internet messaged[sic] to an Internet client based on geographic information of the Internet client. . . .”

It is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “obtaining IP addresses of Internet clients as they visit at least one web site . . . obtaining addresses from the Internet clients . . . transforming the addresses to latitude/longitude coordinates for each of the Internet clients generating a lookup table by correlating the IP addresses with the addresses and latitude/longitude coordinates . . . mining information in the table to resolve multiple entry conflicts to extract most likely position of a particular address . . . obtaining an IP address from the Internet client to be targeted . . . approximating the location of the Internet client by comparing the client’s IP address with the lookup table . . . [and] transmitting a predetermined message to the Internet client, wherein the predetermined message is related to the geographical location of the Internet client.”

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Root lacks an explicit recitation of the “obtaining IP addresses of Internet clients as they visit at least one web site . . . obtaining addresses from the Internet clients . . . transforming the addresses to latitude/longitude coordinates for each of the Internet clients generating a lookup table by correlating the IP addresses with the addresses and latitude/longitude coordinates . . . mining information in the table to resolve multiple entry conflicts to extract most likely position of a particular address . . . obtaining an IP address from the Internet client to be targeted . . . approximating the location of the Internet client by comparing the client’s IP address with the lookup table . . . transmitting a predetermined message to the Internet client, wherein the predetermined message is related to the geographical location of the Internet client. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “obtaining IP addresses of Internet clients as they visit at least one web site . . . obtaining addresses from the Internet clients . . . transforming the addresses to latitude/longitude coordinates for each of the Internet clients generating a lookup table by correlating the IP addresses with the addresses and latitude/longitude coordinates . . . mining information in the table to resolve multiple entry conflicts to extract most likely position of a particular

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address . . . obtaining an IP address from the Internet client to be targeted . . . approximating the location of the Internet client by comparing the client's IP address with the lookup table . . . transmitting a predetermined message to the Internet client, wherein the predetermined message is related to the geographical location of the Internet client. . . ." because such selection would have provided *"a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . ."* (see Root (col. 2 ll. 40-43).

As per claim 2, Root shows the method of claim 1. (See the rejection of claim 1 supra).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests "wherein the predetermined message is sponsored by a third party within a predetermined geographical distance from the Internet client's geographical location."

Root lacks an explicit recitation of the "wherein the predetermined message is sponsored by a third party within a predetermined geographical distance from the Internet client's geographical location. . . ." even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

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It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “wherein the predetermined message is sponsored by a third party within a predetermined geographical distance from the Internet client’s geographical location. . . .” because such selection would have provided *“a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .”* (see Root (col. 2 ll. 40-43).

As per claims 3-8, Root shows the method of claim 1 and subsequent base claims depending from claim 1.

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows elements that reasonably suggest the elements and limitations of claims 3-8.

Root lacks an explicit recitation of the elements and limitations of claims 3-8 even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with the

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elements and limitations of claims 3-8 because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43).

As per claim 9, Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows “A method of targeting at least one geographically based message to at least one Internet client of at least one web site server. . . .”

Recall, it is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “providing a database correlating IP addresses with geographical information . . . acquiring at least one generic messaging space from at least one web site . . . obtaining an IP address of the Internet client when the Internet client visits the web site. . . . determining the geographical location of the Internet client based on one of IP address and a stored cookie . . . transmitting a first message to the Internet

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client through the web site, wherein the first message is related to the geographic location of the Internet client.”

Root lacks an explicit recitation of “providing a database correlating IP addresses with geographical information . . . acquiring at least one generic messaging space form at least one web site . . . obtaining an IP address of the Internet client when the Internet client visits the web site. . . . determining the geographical location of the Internet client based on one of IP address and a stored cookie . . . transmitting a first message to the Internet client through the web site, wherein the first message is related to the geographic location of the Internet client. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “providing a database correlating IP addresses with geographical information . . . acquiring at least one generic messaging space form at least one web site . . . obtaining an IP address of the Internet client when the Internet client visits the web site . . . determining the geographical location of the Internet client based on one of IP address and a stored cookie . . . transmitting a first message to the Internet client through the web site, wherein the first message is related to the geographic location of the Internet client. . . .” because such selection would have provided “*a system by which advertisers can present*

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geographically and demographically targeted messages to a highly well defined group of potential customers. . . .” (see Root (col. 2 ll. 40-43).

As per claim 10, Root shows the method of claim 9. (See the rejection of claim 9 supra).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “transmitting a secondary message to the Internet client after the Internet client responds to the first message, wherein the secondary message is one of the following: a coupon, a document, or a map.”

Root lacks an explicit recitation of the “transmitting a secondary message to the Internet client after the Internet client responds to the first message, wherein the secondary message is one of the following: a coupon, a document, or a map. . . .” even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the invention that the teachings of Root would have been selected in accordance with “transmitting a secondary message to the Internet client after the Internet client responds to the first message, wherein the secondary message is one of the following: a coupon, a

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document, or a map. . . .” because such selection would have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43).

As per claim 11, Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) shows “A method of using a computer to transmitting[sic] targeted information to an Internet client of a web server. . . .”

Recall, it is well settled in the law that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. (See *Merck & Co. Inc. V. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests “collecting IP addresses from a plurality of Internet clients . . . collecting geographical addresses from the plurality of Internet clients . . . geocoding each of the collected geographical addresses to generate location information for each of the geographical attributes . . . generating a look-up table substantially correlating the IP addresses to the location information . . . collecting the IP address of the Internet client . . . generating a location information for that Internet client based on the

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look-up table . . . retrieving a target information relating to the location information . . .
[and] transmitting the targeted information to the Internet client while the Internet client is
accessing the web server.”

Root lacks an explicit recitation of the “collecting IP addresses from a plurality of
Internet clients . . . collecting geographical addresses from the plurality of Internet clients .
. . . geocoding each of the collected geographical addresses to generate location
information for each of the geographical attributes . . . generating a look-up table
substantially correlating the IP addresses to the location information . . . collecting the IP
address of the Internet client . . . generating a location information for that Internet client
based on the look-up table . . . retrieving a target information relating to the location
information . . . [and] transmitting the targeted information to the Internet client while the
Internet client is accessing the web server. . . .” even though Root (the ABSTRACT; FIG.
8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col.
6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests same.

It would have been obvious to a person of ordinary skill in the art the time of the
invention that the teachings of Root would have been selected in accordance with
“collecting IP addresses from a plurality of Internet clients . . . collecting geographical
addresses from the plurality of Internet clients . . . geocoding each of the collected
geographical addresses to generate location information for each of the geographical
attributes . . . generating a look-up table substantially correlating the IP addresses to the

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location information . . . collecting the IP address of the Internet client . . . generating a location information for that Internet client based on the look-up table . . . retrieving a target information relating to the location information . . . [and] transmitting the targeted information to the Internet client while the Internet client is accessing the web server. . . .” because such selection would have provided *“a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .”* (see Root (col. 2 ll. 40-43).

As per claims 12-13, Root shows the method of claim 11. (See the rejection of claim 11 supra).

Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests the elements and limitations of claims 12-13.

Root lacks an explicit recitation of the elements and limitations of claims 12-13, even though Root (the ABSTRACT; FIG. 8; FIG. 9; FIG. 12; col. 1, ll. 26-57; col. 2, ll. 33-40; col. 3, ll. 50-62; col. 4, ll. 4-60; col. 6, ll. 12-67; col. 8, ll. 1-67; col. 9, ll. 1-67; and col. 10, ll. 1-67) reasonably suggests same.

“Official Notice” is taken that both the concepts and the advantages of the elements and limitations of claims 12-13 were well known and expected in the art by one of ordinary skill at the time of the invention because such concepts and advantages would

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have provided “*a system by which advertisers can present geographically and demographically targeted messages to a highly well defined group of potential customers. . . .*” (see Root (col. 2 ll. 40-43)).

CONCLUSION

4. Any response to this action should be mailed to:

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(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

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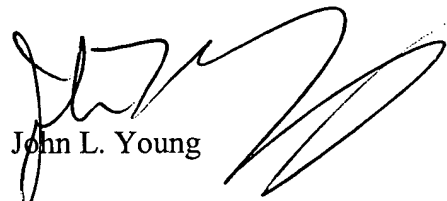
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young
Patent Examiner

May 19, 2003